

Remarks/Arguments

A. Claims in the Case

Claims 1-4, 6-9, 11-25, 27-39, 41-46, and 58-61 are pending. Claims 47-51 and 53-56 have been cancelled. Claims 1, 17, and 31 have been amended.

B. The Claims Are Not Obvious Over Huffman in View of Kuwamoto and further in view of Abbruzzese Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-4, 9, 16-20, 25, 30-34, 39, 46-49, 56-58, and 60-61 as being obvious over U.S. Patent No. 5,870,711 to Huffman (“Huffman”) in view of U.S. Patent No. 5,483,632 to Kuwamoto et al. (“Kuwamoto”) and U.S. Patent No. 5,557,515 to Abbruzzese et al. (“Abbruzzese”) and further in view of U.S. Patent No. 5,307,262 to Ertel (“Ertel”) under 35 U.S.C. § 103(a). Applicant respectfully disagrees with these rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner* et al., 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

With respect to Huffman, the Office Action of May 27, 2004 states:

Huffman teaches a method comprising: an insurance claims processing program generating a request to display a message wherein the message text is configured to assist a user in processing an insurance claim using the insurance claims processing program.

Huffman fails to explicitly disclose: ...

displaying a matching message text corresponding to the requested message code.

Applicant submits that Huffman does not teach or suggest the recited features of Applicant's claims.

Applicant's amended claim 1 recites, in part:

automatically generates a request to display a message to the user based on the displayed processing steps, wherein the request comprises a requested message code;

automatically searches the database for a matching entry which matches the requested message code, wherein the database stores a plurality of entries including the matching entry;

automatically retrieves the matching entry from the database in response to said searching the database for the matching entry which matches the requested message code, wherein the matching entry comprises a matching message text;

automatically displaying the matching message text corresponding to the requested message code, wherein the message text is configured to assist a user in processing an insurance claim using the insurance claims processing program, and wherein the message text is displayed along with one or more of the processing steps; and

Support for the amendments to the claims may be found in Applicant's specification, which states, in part:

In one embodiment, on receiving a trauma-induced bodily injury, a customer may file an insurance claim with his/her insurance organization to cover medical and other accident-related expenses. An IC may utilize a computer-based insurance claim processing system to process insurance claims. In one embodiment, the processing may include estimating a value associated with the filed insurance claim.

(Specification, page 9, lines 1-5)

As used herein, an IC insurance claim processing includes a series of instructions executed by a computer system for processing an IC's business transactions. A claim processing system may include one or more processing tasks. A processing task may include a sequence of one or more processing steps or an ordered list or a structured list of one or more processing steps, associated with the business transaction to be processed by the claim processing system.

(Specification, page 9, lines 13-18)

In one embodiment, each processing step may have one or more associated messages. The primary purpose of these messages may be to display additional information related to the current step, solicit a user input, advise user of the current status of the processing step, etc. For example, messages displayed may advise the user to provide an input response to a specific question. In another instance, a message may warn the user of an out-of-range input value.

(Specification, page 10, lines 1-6)

In one embodiment, upon startup, the program 60 may provide a graphical user interface to display claims processing related information, including messages, on display screen 50. It may collect user inputs, entered by using user input devices 52 in response to one or more messages displayed on display screen 50, and associated with insurance claims. It may process the user inputs, access an insurance database 40, use the contents of the insurance database 40 to estimate the insurance claim, and store it in memory 30 and/or insurance database 40. The program 60 may display a value of the estimated insurance claim on display screen 50.

(Specification, page 11, lines 21-25)

Applicant submits that Huffman does not appear to teach or suggest the feature of automatically generating a request to display a message. Applicant's claims are directed to a method of processing a bodily injury claim, which includes displaying one or more steps for processing of the claim. As each of the steps is displayed, one or more message requests may be generated, depending on the step that is displayed. Huffman appears to be directed to a method that allows a user to generate a message that is sent out to another party to request information. For example, Huffman states:

A need has arisen for an automated method and system for cargo claim management that ... has the ability to automatically generate correspondence to customers and input information requested by the correspondence ...

CLAIMS.FDL is a form entitled "Maintain Claims Record" contained in the CLAIMS subsystem. This is the main form for the claims system. This form allows the user to add data to a claim, request letters or data from a station, route the claim, close the claim, or move the claim to another queue.

Huffman describes cargo claims processing software which may be used to track the progress of

a cargo claim. The software described by Huffman allows a user of the software to “request letters or data from a station.” The software, upon receiving a request from a user, will generate the correspondence. The “messages” that are generated using Huffman’s software are messages directed to third parties, and not the user of the software. Applicant submits that Huffman does not appear to teach “automatically [generating] a request to display a message to the user based on the displayed processing steps...” in combination with the other features of the independent claim. The Office Action appears to rely on Huffman for the teaching of this feature, and none of the other references have been cited as teaching or suggesting this feature. As such, Applicant submits that the Office Action has not shown that each and every one of the claim limitations if taught in the prior art.

Additionally, the Office Action mailed May 27, 2004 states that:

Abbruzzese teaches estimating a bodily injury general damages value of the insurance claim by processing the insurance claim using the insurance claim processing program...

Applicant respectfully disagrees. Applicant’s amended claim 1 describes software that will:

automatically estimate a bodily injury general damages value of the insurance claim by processing information received regarding the insurance claim using the insurance claim processing program, wherein the insurance claim comprises a bodily injury claim.

Abbruzzese appears to teach software for monitoring the progress of an insurance claim. For example, Abbruzzese states:

In accordance with the present invention, there is provided a system and method for substantially automating work management. To illustrate the capabilities of this system and method, reference is made mainly to the processing of insurance claims.

Abbruzzese, contrary to the allegations of the Office Action, is generally related to the management of work. Applicant submits that Abbruzzese does not appear to teach or suggest a

software application that will "automatically estimate a bodily injury general damages value." Abbruzzese appears to teach that such estimates are determined by a supervisor after all of the relevant information has been collected. For example, Abbruzzese states:

When a supervisor retrieves an unfinished LPTX from the database which has been routed to him for review, he typically fills in certain information in the various LPTX screens including the estimated incurred loss, the estimated incurred allocated expense, special procedures, etc. The supervisor's input generally completes the LPTX. Upon this completion, the supervisor electronically assigns the claim to a particular handler for processing by using a Route/Process screen (see Table XIV). When the LPTX is complete (complete, meaning all initial information available has been input) and the supervisor assigns the claim, a sequential claim number (or record report number) is automatically generated and assigned by the system to every claim resulting from the loss. (A supervisor in the claims office specifies various ranges of claim numbers to be used by the system through a Number Assignment Transaction screen (not shown)). A claim that has not yet been assigned and given a claim number (or record report number) is considered to be "in-process." When the claim has been assigned and has been given a claim number (or record report number) it is considered to be "processed."

As noted in the above-cited section, Abbruzzese appears to teach that a supervisor (not the work management program) determines the estimated value for the claimed loss. As such, Applicant submits that Abbruzzese in combination with the other references does not appear to teach or suggest the feature of "automatically estimating a bodily injury general damages value."

Since the Office Actions do not appear to rely on any of the other references for this feature and this feature does not appear to be taught in any of the other references, Applicant submits that the Office Actions have not shown the all of the features of Applicant's claims are taught in the cited art.

The Office Action states: "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." Applicant respectfully points out, however, that to establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03. Applicant is respectfully

asserting that none of the references cited in the Office Action teach or suggest certain features recited in claim 1. Applicant has singled out specific references cited in the Office Action simply to show that the references relied upon in the Office Action for particular features do not teach or suggest those features.

Furthermore, the Office Action has not stated a prima facie case of obviousness for why Huffman, Kuwamoto, Abbruzzese, and Ertel are combinable. As stated in the MPEP §2142:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added)

Applicant respectfully reminds the Examiner, as stated in MPEP §2141: "The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention (emphasis added)." The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), MPEP § 2143.01.

For at least the above reasons, Applicant asserts claim 1 and the claims depending thereon are allowable over the cited art. Applicant respectfully requests removal of the §103 rejections of these claims.

Amended claim 17 describes a combination of features including, but not limited to:

customize the message text of at least one entry in the database during an installation of the insurance claims processing program on a computer system, wherein said customizing the message text comprises modifying the message text of the at least one entry during the installation;

receive an insurance claim;

automatically generate one or more processing steps in response to the insurance claim;

automatically display one or more processing steps on the display device;

automatically generate a request to display a message to the user based on the displayed processing steps, wherein the request comprises a requested message code;

automatically search the database for a matching entry which matches the requested message code;

automatically retrieve the matching entry from the database, wherein the matching entry comprises a matching message text;

automatically display the matching message text corresponding to the requested message code on the display device, wherein the message text is configured to assist a user in processing an insurance claim using the insurance claims processing program, and wherein the message text is displayed along with one or more of the processing steps; and

automatically estimate a bodily injury general damages value of the insurance claim by processing information received regarding the insurance claim using the insurance claim processing program, wherein the insurance claim comprises a bodily injury claim.

Amended claim 31 describes a combination of features including, but not limited to:

customizing the message text of at least one of the entry in a database for a particular insurance company during an installation of an insurance claims processing program on a computer system; wherein each entry in the database comprises a message code and a corresponding message text; wherein said customizing the message text comprises modifying the message text of the at least one entry during the installation;

sending an insurance claim to the insurance claim processing program, wherein the insurance claim processing program:

automatically generates one or more processing steps in response to the insurance claim;

- automatically displays one or more processing steps to a user;
- automatically generates a request to display a message to the user based on the displayed processing steps, wherein the request comprises a requested message code;
- automatically searches a database for a matching entry which matches the requested message code, wherein the database stores a plurality of entries including the matching entry, wherein each entry in the database comprises a message code and a corresponding message text;
- automatically retrieves the matching entry from the database in response to said searching the database for the matching entry which matches the requested message code, wherein the matching entry comprises a matching message text;
- automatically displays the matching message text corresponding to the requested message code, wherein the message text is configured to assist a user in processing an insurance claim using an insurance claims processing program, and wherein the message text is displayed along with one or more of the processing steps; and
- automatically estimates a bodily injury general damages value of the insurance claim by processing the information received regarding the insurance claim using the insurance claim processing program, wherein the insurance claim comprises a bodily injury claim.

For similar reasons to those stated above with respect to claim 1, Applicant respectfully submits that claims 17, 31, and 47 and the claims depending thereon are allowable over the cited art. Applicant respectfully requests removal of the §103 rejections of these claims.

C. Additional Comments

Applicant submits that all of the claims are in condition for allowance. Favorable reconsideration is respectfully requested.

Applicant respectfully requests a two-month extension of time to respond to the Notice of Appeal. A fee authorization form in the amount of \$450.00 is enclosed for the extension of time fee. If any further extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-36200/EBM.

Respectfully submitted,



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